

ESTTA Tracking number: **ESTTA328435**

Filing date: **01/25/2010**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

|                        |   |
|------------------------|---|
| Proceeding             | 92051859  |
| Party                  | Defendant<br>Zero Motocycles, Inc.  |
| Correspondence Address | Zero Motocycles, Inc.<br>One Victor Square<br>Scotts Valley, CA 95066<br>UNITED STATES  |
| Submission             | Answer and Counterclaim   |
| Filer's Name           | Mike Rodenbaugh   |
| Filer's e-mail         | mike@rodenbaugh.com   |
| Signature              | /Mike Rodenbaugh/   |
| Date                   | 01/25/2010  |
| Attachments            | ZERO MOTORCYCLES - ANSWER to Pirelli US Cancellation.pdf ( 7 pages )<br>(159832 bytes ) |

**Registration Subject to the filing**

|                                |   |                                 |            |
|--------------------------------|---|---------------------------------|------------|
| Registration No                | 2749340   | Registration date               | 08/12/2003 |
| International Registration No. | NONE  | International Registration Date | NONE       |
| Registrant                     | PIRELLI TYRE S.P.A.<br>VIALE SARCA 222<br>MILAN, 20126<br>ITALY |                                 |            |
| Grounds for filing             | The registered mark is functional.                              |                                 |            |
|                                | The registered mark has been abandoned.                         |                                 |            |
|                                | The registration was obtained fraudulently.                     |                                 |            |

**Goods/Services Subject to the filing**

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| Class 012.<br>All goods and services in the class are requested, namely: tires; pneumatic, semi-pneumatic and solid tires for vehicle wheels; wheels for vehicles, inner tubes, rims, structural and replacement parts therefor |
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

\_\_\_\_\_  
PIRELLI TYRE S.P.A. AND )  
PIRELLI & C. S.P.A., )  
 )  
Petitioners, )  
 )  
v. )  
 )  
ZERO MOTORCYCLES, INC., )  
 )  
Registrant. )  
 )  
 )  
 )  
\_\_\_\_\_)

Cancellation No. **92051859**

Mark: ZERO MOTORCYCLES  
Registration No. 3669900  
Issued: August 18, 2009

**REGISTRANT'S ANSWER TO PETITION FOR CANCELLATION &  
COUNTERCLAIM FOR CANCELLATION OF REGISTRATION NO. 2749340**

Registrant, Zero Motorcycles, Inc., by its attorney, hereby answers the allegations set forth in the Petition For Cancellation as follows:

1. Registrant has insufficient knowledge or information as to the truth of the allegations set forth in Paragraph 1 of the Petition for Cancellation and, therefore, denies said allegations.

2. Registrant has insufficient knowledge or information as to the truth of the allegations set forth in Paragraph 2 of the Petition for Cancellation and, therefore, denies said allegations.

3. Registrant has insufficient knowledge or information as to the truth of the allegations set forth in Paragraph 3 of the Petition for Cancellation and, therefore, denies said allegations.

4. Registrant has insufficient knowledge or information as to the truth of the allegations set forth in Paragraph 4 of the Petition for Cancellation and, therefore, denies said allegations.

5. Registrant has insufficient knowledge or information as to the truth of the allegations set forth in Paragraph 5 of the Petition for Cancellation and, therefore, denies said allegations.

6. Registrant has insufficient knowledge or information as to the truth of the allegations set forth in Paragraph 6 of the Petition for Cancellation and, therefore, denies said allegations.

7. Registrant has insufficient knowledge or information as to the truth of the allegations set forth in Paragraph 7 of the Petition for Cancellation and, therefore, denies said allegations.

8. Registrant has insufficient knowledge or information as to the truth of the allegations set forth in Paragraph 8 of the Petition for Cancellation and, therefore, denies said allegations.

9. Registrant admits the allegations set forth in Paragraph 9 of the Notice of Opposition.

10. Registrant admits the allegations set forth in Paragraph 10 of the Notice of Opposition.

11. Registrant repeats its answers to Paragraphs 1 through 10.

12. Registrant has insufficient knowledge or information as to the truth of the allegations set forth in Paragraph 12 of the Petition for Cancellation and, therefore, denies said allegations.

13. Registrant admits the allegations set forth in Paragraph 13 of the Petition for Cancellation.

14. Registrant denies the allegations set forth in Paragraph 14 of the Petition for Cancellation.

15. Registrant denies the allegations set forth in Paragraph 15 of the Petition for Cancellation.

16. Registrant denies the allegations set forth in Paragraph 16 of the Petition for Cancellation.

17. Registrant denies the allegations set forth in Paragraph 17 of the Petition for Cancellation.

Registrant further denies any and all additional allegations made within the Petition For Cancellation.

WHEREFORE, Registrant prays that the Petition be dismissed.

### **AFFIRMATIVE DEFENSES**

1. Petitioner has abandoned rights in its ZERO mark, and/or other of its ZERO-formative marks, via non-use of the mark with the intent not to continue use, and/or via acts which have caused such mark(s) to lose significance as indicia of origin.
2. Petitioner and/or its predecessors in interest have acquiesced to Applicant's registration and use of a substantially similar mark or marks, for substantially related goods as those that are subject of the registration now opposed by Petitioner.
3. The doctrine of laches bars Petitioner's request for cancellation.
4. Petitioner and/or its predecessors in interest have acquired or maintained the registrations cited in the Notices of Opposition, or any of them, by providing false or misleading information to the US Patent and Trademark Office, thereby committing fraud on the Trademark Office as further set out below and as further subject to proof in this action.

### **COUNTERCLAIM FOR CANCELLATION OF REGISTRATION NO. 2749340**

Applicant hereby petitions to cancel Registration No. 2749340 for the mark ZERO, on the grounds that:

1. The registered mark has been abandoned with respect to the goods and services claimed in the registration.

2. In addition, the registration has been acquired and/or maintained via provision of false or misleading information to the US Patent and Trademark Office, constituting fraud on the Trademark Office.
3. Specifically, Petitioner filed Section 8 and Section 15 affidavits on June 10, 2009 to maintain this registration, which contained false declarations of ongoing use in US commerce.
4. That affidavit swore, under penalty of perjury, that the trademark registrant or its related company, on that date, still used the respective mark on or in connection with "tires; pneumatic, semi-pneumatic and solid tires for vehicle wheels; wheels for vehicles, inner tubes, rims, structural and replacement parts therefor"
5. That affidavit also swore, under penalty of perjury, that such use was evidenced by the specimens then submitted, allegedly "showing the mark as used in commerce on or in connection with any item in this class."
6. Evidence indicates that, as of the date of that affidavit, Petitioner was not selling or otherwise offering in US commerce any such goods under the ZERO mark.
7. Indeed, the specimen filed June 10, 2007 with respect to this Registration promotes the sale of "P ZERO" branded tires, makes no reference to any "ZERO" trademark.
8. On information and belief, Petitioner has never used a ZERO trademark in US commerce, in connection with any goods or services.
9. The aforementioned evidence, among other evidence, proves that Petitioner executed a sworn affidavit and provided misleading evidentiary specimens in order

to maintain the subject registration, even though Petitioner and/or its counsel of record knew or should have known that the declarations of use in commerce were false and that their specimens did not support those declarations.

10. Pursuant to Medinol and other decisions of the Trademark Trial and Appeal Board, such a false declaration constitutes fraud on the Trademark Office, requiring cancellation of the registration.

THEREFORE, Applicant respectfully requests that the Petition be dismissed, and that Registration No. 2749340 for the mark ZERO be cancelled.

Dated: January 25, 2010

ZERO MOTORCYCLE, INC.

By: /s/ Mike Rodenbaugh

Michael L. Rodenbaugh  
Rodenbaugh Law  
548 Market Street  
San Francisco, CA 94104  
Tel: (415) 738-8087  
California Bar No. 179059

**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing **REGISTRANT'S ANSWER TO PETITION FOR CANCELLATION & COUNTERCLAIM FOR CANCELLATION OF REGISTRATION NO. 2749340** has been served on Virginia Carron, counsel for opposing party, by delivering a copy via email as previously agree, at:

Ms. Virginia Carron  
Finnegan, Henderson, Farabow, Garrett, and Dunner L.L.P.  
901 New York Avenue, N.W.  
Washington, D.C. 20001-4413  
TEL: (404) 653-6452  
FAX: (404) 653-6444  
EMAIL: Virginia.carron@finnegans.com

Respectfully submitted,

Date: January 25, 2010

ZERO MOTORCYCLES, INC.

By: /s/ Mike Rodenbaugh

Michael L. Rodenbaugh

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San Francisco, CA 94104  
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